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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,422	03/21/2001	Emin Tuncay Ustuner	10593/4	4075
757	7590	07/21/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 07/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,422

Applicant(s)

USTUNER, EMIN TUNÇAY

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-72, 74-79 and 82 is/are allowed.
- 6) ☒ Claim(s) 48-50, 73, and 81 is/are rejected.
- 7) ☒ Claim(s) 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/05/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 48-50 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,306,281 to Beurrier. Regarding Claim 48, Beurrier discloses a method for “semi-automatic knot tying” [Column 1, lines 37-43]. Beurrier discloses a driving handle (135) and a needle (102) at the other end of the instrument. The user must prearrange the suture thread before driving the needle, but with one triggering event, the needle forms a *partially tied loop* [Column 2, lines 43-48]. The user must then manually tighten the knot, which Beurrier implies has already been formed. The tightness of the knot is only a relative matter, and even the Applicant’s invention leaves the tightening of the knot to the user [Specification, page 5, line 16-19]. Therefore, even though Beurrier’s knot is not completely tightened, he is still forming a knot. His knot is formed “by looping the thread around sloped extension 116 and through open throat area 114” *not by a procedure formed thereafter* (such as manual intervention) [Column 6, lines 11-13]. Thus, when the needle swings through the gap (114) [see Fig. 1], a partially tied knot will be formed.
3. Regarding Claim 49, Beurrier *implicitly* discloses cutting the suture on both sides of the knot after tying the knot. Beurrier tells us that the intent of his invention is to suture tissues that have been opened up for one reason or another [Column 2, lines 40-48]. Obviously, Beurrier will want to remove the dangling/long ends of the knot that will only interfere with the body and not serve any purpose. He will need to cut the side of the suture with the needle (102) attached to it in order to remove the needle from the body.

Art Unit: 3731

4. Regarding Claims 50 and 81, Beurrier implicitly discloses a delivery system that is capable of suturing repeatedly. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It is clear that Beurrier's invention can be used again with another suture.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,306,281 to Beurrier. Beurrier does not disclose tightening the knot using his machine, but instead it is assumed that he does so manually rather than automatically. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to use Beurrier's machine to tighten the knot since it has been held that broadly providing a mechanical or automatic means to replace manual activity, which has accomplished the same result, involves only routine skill in the art.

Allowable Subject Matter

6. Claims 51-72, 74-79, and 82 are allowed.

7. Claim 80 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 04/28/2004 have been fully considered but they are not persuasive. Beurrier's machine is *automatic*: Column 5, lines 51-55 describe an automatic (not manual) procedure for firing/moving the needle and effecting a knot, such as electronics or a mechanically powered pump. Such an automatic procedure would be analogous to firing a gun (another automatic procedure). One pulls the trigger, and a bullet *automatically* is fired.

Further, arguing that Beurrier's machine does not tie a knot is *counter to what is explicitly stated in Beurrier's disclosure*. Column 1, lines 40-43 explicitly say that Beurrier's invention is different from the prior art because it has "automatic knot tying capabilities." Further, in Column 2, lines 14-18, Beurrier explains that his invention has "semi-automatic" knot tying capability, meaning that the looping mechanism is included in his machine. What good would the apparatus do if the needle/suture did not make a complete loop? Clearly the needle/suture *must go through at least some portion of the preformed loop (103)* [see Figures 9 and 10] during the journey of the needle across gap (114) [see Fig. 1]. Examiner maintains his position that Beurrier's device is an automatic knot tying device because *Beurrier explicitly says the same*.

Art Unit: 3731

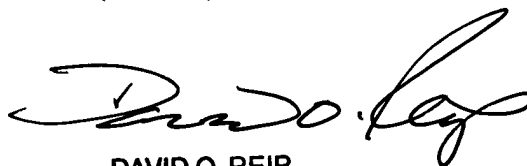
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaver or McDermott can be reached on (703) 308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP

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July 15, 2004



DAVID O. REIP
PRIMARY EXAMINER